



1425.67029

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of )

Applicant: Jack K. Hosking et al. )

Serial No.: 10/689,452 )

Filed: October 20, 2003 )

For: RAIL FASTENER DRIVER )  
WITH ENHANCED )  
FASTENER POSITIONING )

Art Unit: Unassigned )

Examiner: Unassigned )

*I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.*

December 22, 2003

Date

*Lawrence J. CRAIN*  
Attorney for Applicant(s)  
Registration No. 31,497TRANSMITTAL

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Enclosed is:

(X) Petition for Retroactive License Pursuant to 37 C.F.R. §5.25.

(X) Check in the amount of \$130.00.

(X) If a Petition under 37 C.F.R. 1.136(a) for an extension of time for response is required to make the attached response timely and does not separately accompany this transmittal, Applicants hereby petition under 37 C.F.R. 1.136(a) for an extension of time for response in the above-identified application for the period required to make the attached response timely.

(X) The Commissioner is hereby authorized to charge any additional fees which may be required to this application under 37 C.F.R. 1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. A duplicate copy of this sheet is enclosed.

300 South Wacker Drive-Suite 2500  
Chicago, Illinois 60606  
Telephone: (312) 360-0800  
Facsimile: (312) 360-9315  
Customer Number 24978

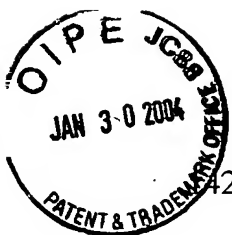
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Respectfully Submitted,

GREER BURNS &amp; CRAIN, LTD.

By

*Lawrence J. CRAIN*  
Lawrence J. CRAIN  
Registration No. 31,497



425.67029

## PATENT APPLICATION

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December 22, 2003

Date

*Lawrence J. Chan*  
Attorney for Applicant(s)  
Registration No. 31,497

**PETITION FOR RETROACTIVE LICENSE**  
**PURSUANT TO 37 C.F.R. § 5.25**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant's Attorney respectfully petitions for retroactive license in the above-identified application. Applicant's undersigned Attorney caused the above-identified application to be filed in Canada on October 20, 2003 without the grant of a foreign filing license. The undersigned, having first hand knowledge of the facts, hereby states that the filing of the Canadian application occurred through error and without deceptive intent. As required by 37 C.F.R. § 1.17(h), the fee for petition of \$130 is enclosed herewith.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that

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such willful false statements may jeopardize the validity of the application or any resulting patent grant, declares that he is properly authorized to execute this application on behalf of the Applicant; and that all statements made of his own knowledge are true, and statements made on information and belief are believed to be true.

Applicant's Attorney states that:

(a) The corresponding foreign application was filed in Canada on October 20, 2003.

(b) The subject matter in question was not under a secrecy order at the time it was filed in Canada, and the subject matter in question is not currently under a secrecy order.

(c) Applicant's Attorney diligently sought a license after discovery of the proscribed foreign filing by submitting herewith a petition for retroactive license shortly after receiving the report from the Canadian foreign associate regarding the Canadian filing.

(d) Applicant's Attorney filed in Canada through error, and without deceptive intent, without the required license under 37 C.F.R. § 5.11 first having been obtained. The facts supporting the conduct that constitutes error without deceptive intent are as follows:

a. Nordco Inc. is the Applicant of the above-identified application.

b. B. Straub, Vice President of Engineering at Nordco Inc., contacted Applicant's Attorney on September 24, 2003, disclosed the subject matter that is the invention of the above-identified application to Applicant's Attorney, and notified

Applicant's Attorney that field testing of the subject matter of the above-identified application commenced on or about October 21, 2002.

c. Between September 24, 2003 and October 20, 2003, Applicant's Attorney prepared the application for filing in the United States and Canada.

d. Between September 24, 2003 and October 20, 2003, Applicant's Attorney failed to obtain a foreign filing license from the United States Patent and Trademark Office.

e. On October 17, 2003, Applicant's Attorney instructed, via e-mail with the order letter attached, the Canadian foreign associate, Mr. Alain Bourassa of the firm Perley-Robertson, Hill & McDougall LLP, located at 90 Sparks Street, Ottawa Ontario, K1P 1E2, Canada, to prepare and file immediately and upon final confirmation, but no later than October 20, 2003, an application in Canada based on the above-identified U.S. Patent Application, also filed on October 20, 2003, in which there was no Serial Number or foreign filing license.

f. Applicant's Attorney instructed the Canadian foreign associate to file no later than October 20, 2003 in order to meet the Canadian requirements for filing within a year of the invention being publicly disclosed. Section 28.2 (1)(a) of the Canadian Patent Act requires that the subject-matter defined by a claim in an application for a patent in Canada must not have been disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere;

g. The legal assistant to the Canadian foreign associate, Maureen Choo, acknowledged receipt of the instructions on October 20, 2003.

h. Applicant's Attorney sent confirmation regarding final approval of the specification to the Canadian foreign associate on October 20, 2003.

i. The Canadian foreign associate filed the application in the Canadian Patent Office on October 20, 2003.

j. Applicant's Attorney filed an application on the same subject matter in the United States Patent and Trademark Office on October 20, 2003.

k. The Canadian foreign associate reported the filing of the Canadian application to Applicant's Attorney on October 20, 2003, which was received by Applicant's Attorney on October 27, 2003.

Applicant's Attorney asserts that error without deceptive intent was committed in filing the application in Canada on the same day the application was filed in the United States, therefore not enabling adequate time for a foreign filing license to be granted by the United States Patent and Trademark Office. Applicant's Attorney further asserts that Canadian Patent Law necessitated filing the application in Canada on October 20, 2003 in order to avoid Applicant's loss of rights due to the possible disclosure of the invention on October 21, 2002.

Enclosed are the following documents and fees:

(i) Petition fee pursuant to 37 C.F.R. § 1.17(h) for retroactive license in the amount of \$130;

(ii) A copy of the e-mail, dated October 17, 2003, and the attached order letter to the Canadian foreign associate regarding instructions for filing the application in Canada.

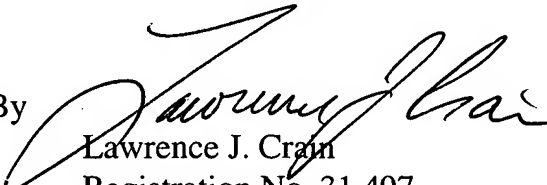
(iii) A copy of two e-mails, both dated October 20, 2003, from the legal assistant to the Canadian foreign associate confirming receipt of instructions.

(iii) A copy of the report letter to Applicant's Attorney, dated October 20, 2003, including a copy of the Canadian application.

The Commissioner is authorized by the undersigned to charge any additional fees which may be required to this application, or credit any overpayment, to Deposit Account No. 07-2069. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. A duplicate of this Petition is enclosed.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By   
Lawrence J. Crain  
Registration No. 31,497

December 22, 2003

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